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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,242	08/14/2000	Cali St.John	946-5	8391

7590

07/08/2002

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EXAMINER

ROSSI, JESSICA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 07/08/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,242

Applicant(s)

ST. JOHN, CALI

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/28/02, Amendment A, paper no. 4.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: copy of claims from copending application 09/951,723.

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DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 5/28/02. Claims 1-15 are pending.
2. The rejection of claims 1, 5, 6, 9-10 and 12 under 35 U.S.C. 102(e) as being anticipated by Bjornsen (of record) as set forth in the previous office action, paper no. 3, has been withdrawn due to the new limitation of conveying "by revenue producing sale".
3. The rejection of claims 1, 3-8 and 12-15 under 35 U.S.C. 103(a) as being unpatentable over Granofsky (of record) in view of the collective teachings of Bjornsen, Saliba et al. (of record) and Stasiuk (of record) as set forth in the previous office action has been withdrawn due to the new limitation of conveying "by revenue producing sale".

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-2, 5-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjornsen (US 6296137; of record) in view of Blotky et al. (US 6084526) and the Admitted Prior Art in the specification of the present application.

With respect to claim 1, Applicants are directed to paragraph 6 of the previous office action for a complete discussion of the Bjornsen reference. Bjornsen is silent as to the conveying being by revenue producing sale.

It is known in the art to display advertising/promotional information on beverage and food containers wherein this information can be related to other products made by the company selling the container, or alternatively, **the information can be related to products sold by**

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another company, as taught by Blotky et al. (column 1, lines 6-7; column 2, line 23; column 4, lines 1-2 and 12-18). One of ordinary skill in the art at the time the invention was made would have readily appreciated that, in a capitalist economy, the company selling the containers would not promote another company's product for free and therefore would charge that company an advertising fee resulting in a revenue producing sale for the container company. Furthermore, it is well known in the advertising industry to develop new and innovative sites for the placement of revenue producing advertising wherein third parties purchase the right to attach such advertising to a product that is not supplied and/or sold by the third party, as taught by the Admitted Prior Art in the specification of the present application (page 5, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to convey by revenue producing sale the right to attach the indicia to the protective members of Bjornsen by selling the right to third parties because such is known, as taught by Blotky et al. and the Admitted Prior Art, wherein this practice is a source of revenue for the inventors that can offset the cost of the invention.

Regarding claim 2, Applicants are invited to reread the rejection of claim 1.

Regarding claims 5-6, 9-10 and 12, Applicants are directed to paragraph 6 of the previous office action.

Regarding claims 7-8 and 13-15, Applicants are directed to paragraph 10 of the previous office action.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bjornsen, Blotky et al. and the Admitted Prior Art as applied to claim 1 above, and further in view of Granofsky (US 5108003; of record).

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Applicants are directed to paragraph 9 of the previous office action.

7. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjornsen, Blotky et al. and the Admitted Prior Art as applied to claim 6 above, and further in view of Nieuwoudt (US 5996832; of record).

Applicants are directed to paragraph 11 of the previous office action.

8. Claims 1-8 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granofsky in view of the collective teachings of Bjornsen, Saliba et al. (US 4124138; of record) and Stasiuk (US 6105806; of record), Blotky et al. and the Admitted Prior Art in the specification of the present application.

With respect to claim 1, Applicants are directed to paragraph 12 of the previous office action for a complete discussion of the Granofsky reference. Granofsky is silent as to the conveying being by revenue producing sale.

It is known in the art to display advertising/promotional information on beverage and food containers wherein this information can be related to other products made by the company selling the container, or alternatively, **the information can be related to products sold by another company**, as taught by Blotky et al. (column 1, lines 6-7; column 2, line 23; column 4, lines 1-2 and 12-18). One of ordinary skill in the art at the time the invention was made would have readily appreciated that, in a capitalist economy, the company selling the containers would not promote another company's product for free and therefore would charge that company an advertising fee resulting in a revenue producing sale for the container company. Furthermore, it is well known in the advertising industry to develop new and innovative sites for the placement of revenue producing advertising wherein third parties purchase the right to attach such

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advertising to a product that is not supplied and/or sold by the third party, as taught by the Admitted Prior Art in the specification of the present application (page 5, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to convey by revenue producing sale the right to attach the indicia to the protective members of Granofsky by selling the right to third parties because such is known, as taught by Blotky et al. and the Admitted Prior Art, wherein this practice is a source of revenue for the inventors that can offset the cost of the invention.

Regarding claim 2, Applicants are invited to reread the rejection of claim 1.

Regarding claims 3-8 and 12-15, Applicants are directed to paragraph 12 of the previous office action.

9. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granofsky, the collective teachings of Bjornsen, Saliba et al. and Stasiuk, Blotky et al. and the Admitted Prior Art in the specification of the present application as applied to claim 6 above, and further in view of Nieuwoudt.

Applicants are directed to paragraph 14 of the previous office action.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-3, 10-13 and 18-23 of copending Application No. 09/951,723. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application encompass the limitations in the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

12. Applicant's arguments filed 5/28/02 have been fully considered but they are not persuasive.

13. On page 2 of the arguments, Applicants argue that none of the references, including the Admitted Prior Art, that were cited in the previous office action taught or suggested the sale of revenue producing indicia or advertising.

The examiner directs Applicants to paragraphs 5 and 8 of the present office action pertaining to the Admitted Prior Art and how it discusses revenue producing advertising using those exact words (page 5, line 14 of present specification).

14. On page 2 of the arguments, Applicants argue that despite having amended claim 1 to specify that the conveyance is a revenue producing sale, the term "conveying" means selling advertising to an unrelated entity for money.

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The examiner respectfully points out that "conveying" has a variety of meanings wherein one could simply be giving an unrelated entity permission to attach advertising to his/her product free of charge.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi
Patent Examiner
Art Unit 1733



jl
July 3, 2002



Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700